

**REMARKS**

[0001] The following paragraphs are numbered for ease of future reference. Claims 1-2, 4-5, 7,15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67, 69-70 are all the claims presently pending in this application. Claim 62 has been amended to overcome the Examiner's 35 U.S.C. §101 rejection.

[0002] Applicant further respectfully submits that no new matter is added to the currently amended claims, nor has the scope of the pending claims changed. Applicant respectfully traverses the rejections based on the following discussion.

[0003] Applicant notes that the Office Action Summary indicates that claims 67, 69 and 70 are rejected. However, the Examiner does not provide any basis for his rejection of these claims in the Office Action. Therefore, Applicant presumes that the Office Action Summary was incorrect and that these claims are allowable. Thus, "wherein said optimization process is limited by parameters comprising which e-coupons should be included, an expiration date of said e-coupons, and a total number of e-coupons used," should be indicated as allowable subject matter.

[0004] Applicant submits that should the Examiner maintain that these claims are other than allowed, that the Examiner must provide Applicant with a basis for the rejection of these claims in another Non-Final Office Action so that Applicant can have an opportunity to respond to the Examiner's arguments.

**I. REJECTION UNDER 35 U.S.C. §101**

[0005] Claims 62, 64, 66 and 70 have been rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter as not (1) being tied to a particular machine or apparatus, or

(2) transforming a particular article to a different state or thing.

[0006] Applicant's amendment also satisfies the two corollaries of the “**machine-or-transformation**” test of *In re Bilsky*, since the amendment: 1) is not merely field-of-use limitation by imposing meaningful limits on the method claim's scope; and 2) does not merely add insignificant extra-solution activity by reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

[0007] Specifically, Applicant has amended claim 62 to recite, “a hardware module adapted to...,” and deleted the “software module” element. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

## II. THE PRIOR ART REJECTIONS

### A. The 35 U.S.C. § 103(a) Rejection over Falkowski

[0008] Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Falkowski, U.S. Pat. No. 6,932,270, (hereinafter “Falkowski”).

[0009] The Examiner on page 3 of the Non-Final Office Action alleges that one of ordinary skill in the art would have been motivated to modify Falkowski to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61-62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0010] Applicant traverses the Examiner's rejection since, among other reasons, Falkowski is

directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. The bar code scanner allows users to scan into the memory means the bar codes on coupons wherever a user may find the coupons. The display screen allows the user to view information concerning each coupon such as what product is represented by the coupon and the discount provided by the coupon. The microprocessor and operational keys allow the user to initiate the scanning of bar codes and arrange into various categories the coupons in the memory of coupon card, while the communications port will allow the transfer of coupon bar codes to a periphery device. See column 3, line 57 to column 4, line 5.

[0011] Meanwhile, Applicant's claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

[0012] More specifically, Applicant submits, that Falkowski teaches or suggests:

*“recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,”* per Applicant's independent claims 1, 15, 22, 49 and similarly,

*“wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,”* per Applicant's independent claim 62.

[0013] The Examiner admits that Falkowski fails to teach or suggest the above recited claim limitation. However, the Examiner alleges that “Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-

43].”

[0014] Falkowski states at column 19, lines 38-43:

The routine will also place next to the coupon on display screens 102 and 109 a message 130 (as seen in FIG. 12) indicating why each coupon is not appropriate for redemption. For example in FIG. 12, the coupon highlighted is not the proper size to be considered appropriate for the product purchased.

[0015] Nowhere is there any teaching or suggestion in the above-identified passage of

“recommending to a user to use an additional e-coupon.” Falkowski merely states that a message will be displayed that indicates “why each coupon is not appropriate for redemption.”

Nowhere is there any teaching or suggestion in this passage, or any other passage in Falkowski of

“recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one of a saved set of e-coupons.”

[0016] The Examiner further states that, “It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a coupon that had been previously saved.”

[0017] Applicant respectfully traverses the Examiner’s above-identified alleged motivation to “combine” or “modify” Falkowski, since there is no mention of the system of Falkowski “recommending the use of saved coupons,” and especially “based on choosing one of a saved set of e-coupons.”

[0018] In summary, Falkowski is directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. Whereas, Applicant’s claimed invention is directed

toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

[0019] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art reference to Falkowski fails to teach or suggest each element and feature of Applicant's claimed invention.

**B. The 35 U.S.C. § 103(a) Rejection over Falkowski further in view of Beach**

[0020] Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Falkowski, further in view of Beach et al., U.S. Pat. App. Pub. No. US2002/10107738, (hereinafter "Beach").

[0021] The Examiner alleges on page 8 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Falkowski with the teaching from Beach to form the invention of claims 34, 60 and 64.

[0022] Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0023] The Examiner admits that Falkowski fails to teach or suggest, "providing recommendations to said user, based on a profile of said user, in relation to a user selected set of e-coupons." However, the Examiner alleges that the disclosure of Beach teaches or suggests Applicant's claimed invention.

[0024] Beach discloses at paragraph [0035], that "the service center may suggest items or coupons to the user, e.g., for based on information stored or accessible to the service center 112

regarding the consumer or the consumer's family or other group.”

However, even assuming *arguendo* that the Examiner’s position has some merit, Beach fails to teach or suggest, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claims 1, 15, 22, 49 and similarly, “wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claim 62.”

Therefore, Beach fails to overcome the deficiencies of Falkowski.

[0025] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Falkowski and Beach (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**C. The 35 U.S.C. § 103(a) Rejection over Falkowski further in view of Marmon**

[0026] Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Falkowski, further in view of Marmon, U.S. Pat. No. 4,446,528, (hereinafter “Marmon”).

[0027] The Examiner alleges at the bottom of page 8 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Falkowski with the teaching from Marmon to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0028] Applicant traverses the Examiner's rejection since, among other reasons, Falkowski is directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. The bar code scanner allows users to scan into the memory means the bar codes on coupons wherever a user may find the coupons. The display screen allows the user to view information concerning each coupon such as what product is represented by the coupon and the discount provided by the coupon. The microprocessor and operational keys allow the user to initiate the scanning of bar codes and arrange into various categories the coupons in the memory of coupon card, while the communications port will allow the transfer of coupon bar codes to a periphery device. See column 3, line 57 to column 4, line 5.

[0029] Meanwhile, Applicant's claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

[0030] More specifically, Applicant submits, that Falkowski teaches or suggests:

"recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons," per Applicant's independent claims 1, 15, 22, 49 and similarly,

"wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons," per Applicant's independent claim 62.

[0031] The Examiner admits that Falkowski fails to teach or suggest the above recited claim limitation. However, the Examiner alleges that "Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not

fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].”

[0032] Falkowski states at column 19, lines 38-43:

The routine will also place next to the coupon on display screens 102 and 109 a message 130 (as seen in FIG. 12) indicating why each coupon is not appropriate for redemption. For example in FIG. 12, the coupon highlighted is not the proper size to be considered appropriate for the product purchased.

[0033] Nowhere is there any teaching or suggestion in the above-identified passage of

“recommending to a user to use an additional e-coupon.” Falkowski merely states that a message will be displayed that indicates “why each coupon is not appropriate for redemption.”

Nowhere is there any teaching or suggestion in this passage, or any other passage in Falkowski of

“recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one of a saved set of e-coupons.”

[0034] The Examiner further states that, “It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase.

It would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a coupon that had been previously saved.”

[0035] Applicant respectfully traverses the Examiner’s above-identified alleged motivation to

“combine” or “modify” Falkowski, since there is no mention of the system of Falkowski “recommending the use of saved coupons,” and especially “based on choosing one of a saved set of e-coupons.”

[0036] In summary, Falkowski is directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a

microprocessor and operational keys. Whereas, Applicant's claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

[0037] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Falkowski and Marmon (either alone or in combination) fail to teach or suggest each element and feature of Applicant's claimed invention.

**D. The 35 U.S.C. § 103(a) Rejection over Falkowski further in view of Beach**

[0038] Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Falkowski, further in view of Beach.

[0039] The Examiner alleges on page 13 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Falkowski with the teaching from Beach to form the invention of claims 34, 60 and 64.

[0040] The Examiner erroneously repeats this exact same rejection in the Non-Final Office Action from page 8, and Applicant respectfully requests that the Examiner either withdraw this rejection or reissue a corrected rejection since they fail to properly include the listing of the combination of prior art reference that reject the independent claims from which they depend.

[0041] Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0042] Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed

invention.

[0043] The Examiner admits that Falkowski fails to teach or suggest, “providing recommendations to said user, based on a profile of said user, in relation to a user selected set of e-coupons.” However, the Examiner alleges that the disclosure of Beach teaches or suggests Applicant’s claimed invention.

[0044] Beach discloses at paragraph [0035], that “the service center may suggest items or coupons to the user, e.g., for based on information stored or accessible to the service center 112 regarding the consumer or the consumer's family or other group.”

[0045] However, even assuming *arguendo* that the Examiner’s position has some merit, Beach fails to teach or suggest, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claims 1, 15, 22, 49 and similarly, “wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claim 62.”

Therefore, Beach fails to overcome the deficiencies of Falkowski.

[0046] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Falkowski and Beach (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**E. The 35 U.S.C. § 103(a) Rejection over Falkowski further in view of Wilkman**

[0047] Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Falkowski, further in view of Wilkman, U.S.

Pat. App. Pub. No. 20020013728, (hereinafter “Wilkman”).

[0048] The Examiner alleges on the bottom of page 13 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Falkowski with the teaching from Wilkman to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0049] Applicant traverses the Examiner’s rejection since, among other reasons, Falkowski is directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. The bar code scanner allows users to scan into the memory means the bar codes on coupons wherever a user may find the coupons. The display screen allows the user to view information concerning each coupon such as what product is represented by the coupon and the discount provided by the coupon. The microprocessor and operational keys allow the user to initiate the scanning of bar codes and arrange into various categories the coupons in the memory of coupon card, while the communications port will allow the transfer of coupon bar codes to a periphery device. See column 3, line 57 to column 4, line 5.

[0050] Meanwhile, Applicant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

[0051] More specifically, Applicant submits, that Falkowski teaches or suggests:

*“recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,”* per Applicant’s independent claims

1, 15, 22, 49 and similarly,

“wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claim 62.

[0052] The Examiner admits that Falkowski fails to teach or suggest the above recited claim limitation. However, the Examiner alleges that “Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].”

[0053] Falkowski states at column 19, lines 38-43:

The routine will also place next to the coupon on display screens 102 and 109 a message 130 (as seen in FIG. 12) indicating why each coupon is not appropriate for redemption. For example in FIG. 12, the coupon highlighted is not the proper size to be considered appropriate for the product purchased.

[0054] Nowhere is there any teaching or suggestion in the above-identified passage of “recommending to a user to use an additional e-coupon.” Falkowski merely states that a message will be displayed that indicates “why each coupon is not appropriate for redemption.” Nowhere is there any teaching or suggestion in this passage, or any other passage in Falkowksi of “recommending to a user to user an additional e-coupon in relation to a purchase based on choosing one of a saved set of e-coupons.”

[0055] The Examiner further states that, “It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the invention to have

recommended this additional coupon even if this is a coupon that had been previously saved.”

[0056] Applicant respectfully traverses the Examiner’s above-identified alleged motivation to “combine” or “modify” Falkowski, since there is no mention of the system of Falkowski “recommending the use of saved coupons,” and especially “based on choosing one of a saved set of e-coupons.”

[0057] In summary, Falkowski is directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. Whereas, Applicant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

[0058] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Falkowski and Wilkman (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**F. The 35 U.S.C. § 103(a) Rejection over Falkowski further in view of Wilkman and Beach**

[0059] Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Falkowski, further in view of Wilkman and Beach.

[0060] The Examiner alleges on page 8 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Falkowski with the teachings from Wilkman and Beach to form the invention of claims 34, 60 and 64.

[0061] Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed

invention.

[0062] Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0063] The Examiner admits that Falkowski fails to teach or suggest, “providing recommendations to said user, based on a profile of said user, in relation to a user selected set of e-coupons.” However, the Examiner alleges that the disclosure of Beach teaches or suggests Applicant’s claimed invention.

[0064] Beach discloses at paragraph [0035], that “the service center may suggest items or coupons to the user, e.g., for based on information stored or accessible to the service center 112 regarding the consumer or the consumer's family or other group.”

[0065] However, even assuming *arguendo* that the Examiner’s position has some merit, Beach fails to teach or suggest, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claims 1, 15, 22, 49 and similarly, “wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claim 62.”

Therefore, Beach fails to overcome the deficiencies of Falkowski.

[0066] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Falkowski, Wilkman and Beach (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**G. The 35 U.S.C. § 103(a) Rejection over Falkowski further in view of Wilkman and Marmon**

[0067] Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Falkowski further in view of Wilkman and Marmon.

[0068] The Examiner alleges at page 19 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Falkowski with the teachings from Wilkman and Marmon to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33, 35, 40-57, 59, 61-62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0069] Applicant traverses the Examiner's rejection since, among other reasons, Falkowski is directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. The bar code scanner allows users to scan into the memory means the bar codes on coupons wherever a user may find the coupons. The display screen allows the user to view information concerning each coupon such as what product is represented by the coupon and the discount provided by the coupon. The microprocessor and operational keys allow the user to initiate the scanning of bar codes and arrange into various categories the coupons in the memory of coupon card, while the communications port will allow the transfer of coupon bar codes to a periphery device. See column 3, line 57 to column 4, line 5.

[0070] Meanwhile, Applicant's claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of

e-coupons.

[0071] More specifically, Applicant submits, that Falkowski teaches or suggests:

“recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claims

1, 15, 22, 49 and similarly,

“wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claim 62.

[0072] The Examiner admits that Falkowski fails to teach or suggest the above recited claim limitation. However, the Examiner alleges that “Falkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43].”

[0073] Falkowski states at column 19, lines 38-43:

The routine will also place next to the coupon on display screens 102 and 109 a message 130 (as seen in FIG. 12) indicating why each coupon is not appropriate for redemption. For example in FIG. 12, the coupon highlighted is not the proper size to be considered appropriate for the product purchased.

[0074] Nowhere is there any teaching or suggestion in the above-identified passage of

“recommending to a user to use an additional e-coupon.” Falkowski merely states that a message will be displayed that indicates “why each coupon is not appropriate for redemption.”

Nowhere is there any teaching or suggestion in this passage, or any other passage in Falkowski of

“recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one of a saved set of e-coupons.”

[0075] The Examiner further states that, “It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a coupon that had been previously saved.”

[0076] Applicant respectfully traverses the Examiner’s above-identified alleged motivation to “combine” or “modify” Falkowski, since there is no mention of the system of Falkowski “recommending the use of saved coupons,” and especially “based on choosing one of a saved set of e-coupons.”

[0077] In summary, Falkowski is directed toward a portable coupon card that includes a bar code scanner, a memory means, a display screen, and a communications port, all controlled by a microprocessor and operational keys. Whereas, Applicant’s claimed invention is directed toward recommending to a user to use an additional e-coupon in relation to a purchase based on choosing one particular saved set of e-coupons.

[0078] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Falkowski, Wilkman and Marmon (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**H. The 35 U.S.C. § 103(a) Rejection over Falkowski further in view of Wilkman and Beach**

[0079] Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Falkowski, further in view of Wilkman and Beach.

[0080] The Examiner alleges on page 22 of the Non-Final Office Action that one of ordinary skill in the art would have been motivated to modify Falkowski with the teaching from Beach to form the invention of claims 34, 60 and 64.

[0081] The Examiner erroneously repeats this exact same rejection in the Non-Final Office Action from page 19, and Applicant respectfully requests that the Examiner either withdraw this rejection or reissue a corrected rejection since they fail to properly include the listing of the combination of prior art reference that reject the independent claims from which they depend.

[0082] Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0083] Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0084] The Examiner admits that Falkowski fails to teach or suggest, “providing recommendations to said user, based on a profile of said user, in relation to a user selected set of e-coupons.” However, the Examiner alleges that the disclosure of Beach teaches or suggests Applicant’s claimed invention.

[0085] Beach discloses at paragraph [0035], that “the service center may suggest items or coupons to the user, e.g., for based on information stored or accessible to the service center 112 regarding the consumer or the consumer's family or other group.”

[0086] However, even assuming *arguendo* that the Examiner’s position has some merit, Beach fails to teach or suggest, “recommending to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s

independent claims 1, 15, 22, 49 and similarly, “wherein said user interface communicates a recommendation to said user to use an additional e-coupon in relation to said purchase based on said choosing one of said saved sets of e-coupons,” per Applicant’s independent claim 62.”

Therefore, Beach fails to overcome the deficiencies of Falkowski.

[0087] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Falkowski and Beach (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

### **III. FORMAL MATTERS AND CONCLUSION**

[0088] In view of the foregoing, Applicant submits that claims 1-2, 4-5, 7,15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67, 69-70, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

[0089] Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic interview.

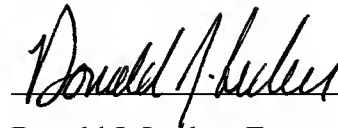
Application No. 09/772,244  
Docket No. JP920000376US1

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[0090] The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Date: October 6, 2009

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Donald J. Lecher", written over a horizontal line.

Donald J. Lecher, Esq.

Registration No. 41,933

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